

## **REMARKS**

The present filing is responsive to the Office Action.

### **Examiner Interview**

Applicant appreciates the opportunity of a telephonic interview with the Examiner on March 24, 2009. While no agreement has been reached with respect to the substantive prior art rejections, Applicant's representative discussed with the Examiner claim amendments that overcame at least the 112 issues raised by the Examiner. The present claim amendments are consistent with such discussion. The parties disagree on whether those amendments would raise new issues after final action.

### **Summary of the Response**

Claims 1, 9, 20, 26, 28 and 29 have been amended. Claims 24 and 25 have been canceled. Claims 2-8, 14-15 and 21 have been previously canceled. Claims 1, 9-13, 16-20, 22, 23 and 26-29 remain pending in this application. Reexamination and reconsideration of the present application as amended are respectfully requested.

### **Claim Rejections Under 35 USC 112**

Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 9, 24-26 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These rejections are respectfully traversed.

Claims 9, 24, 25, 28 and 29 has been amended to address the Examiner's concerns. The amendments are clearly supported by the specification. Applicant notes that the present amendments to claims 24, 25, 28 and 29 are being made to further clarify the claims as a compromise to reduce issues for the interest to further prosecution of this case, even though Applicant does not believe the claims were unclear in the first place.<sup>1</sup>

At the interview, the Examiner noted that the proposed amendments would raise new issues. Applicant respectfully disagrees, for at least the reasons below.

Dependent claim 9 as amended merely corrected an obvious claim dependency error due to prior cancellation of an intervening claim that had been incorporated in independent claim 1. The amendment to claim 9 therefore does not raise any new issue.

The limitations of previously presented dependent claim 24 are currently incorporated into independent claim 1. Given that claim 24 previously depended directly on claim 1, the incorporation of claim 24 into claim 1 in and by itself does not raise any new issue.

To address the Examiner's 112 concerns raised in the present final action, the limitations of claim 24 has been currently amended to make clear that the material of the third conductive layer is different from that of the first and second conductive layers. Applicant respectfully submits that such clarifying amendment in response to the Examiner's 112 concerns should not be deemed to raise any new issue requiring further consideration after final.

Applicant respectfully submits that the Examiner erroneously considered the third conductive layer having a material different from a material of the claimed first and second

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<sup>1</sup> In paragraph 9 of the present action, the Examiner commented that if Applicant believes that the rejections to certain claims in the previous office action are improper, Applicant should not amend those claims. Applicant is not aware of the prohibition against making an effort to accommodate the Examiner's rejections by making appropriate amendments as a compromise to reduce issues for the interest to further prosecution.

substrates. Such interpretation is not reasonable within the context of the present invention and as previously presented in claim 24 (and now claim 1 as amended).

Previously presented claim 24 recited: “wherein the first and second conductive layers are conductively coupled by a third conductive layer of a different material”. It would not be reasonable to deem the third conductive layer of a different material with respect to the first and second substrates. The Examiner relied on the fact that the first and second substrates are disclosed to be a plastic material and the third conductive layer is disclosed to be a metal material, to support his interpretation of claim 24. This interpretation is unreasonable, as the Examiner should not just simply pick any interpretation, and in this case a more remote interpretation, when there is a closer interpretation for purpose of further substantive consideration of the claims, in a situation when the claim is deemed to be unclear.<sup>2</sup> When a claim is subject to a 112 inquiry, for purpose of further substantive consideration of the claim, the Examiner is obligated to consider the claim in a manner reasonably supported by the specification within the context of the claim, so that the substantive consideration would be more productive and informative to Applicant with respect to the patentability of the claim (e.g., if there are no prior art rejections, the affected claim would be indicated as being allowable pending correction of certain 112 issues). With such consideration, Applicant would be given a fair and reasonable opportunity to address the substantive prior art rejections, or simply correct the 112 issues to conclude prosecution if there are no substantive prior art rejections. Instead in this case, the Examiner picked an easy, but remote interpretation of the claim in the haste of disposal of this case, and as a result failed to provide a more substantive rejection based on the best prior art references. If one were to use the Examiner’s approach, one could have related the

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<sup>2</sup> As noted above, Applicant is not conceding to the Examiner’s position that claim 24 was unclear in the first place. In fact, Applicant respectfully believes claim 24 as previously presented is clear on its face.

third conductive to any other structure besides the substrates recited in the claim. The question is where the Examiner should decide to draw the line? Instead of being subject to deciding on such question, the proper approach would be to give the affected claim an interpretation closest to the context of the claim as supported by the specification for purpose of furthering substantive prior art considerations.

In this case, the reasonable interpretation of previously presented claim 24 (now claim 1) in the context of the language of the claim would render consideration of the third conductive layer being of a different material is in reference to the first and second conductive layers. This interpretation is fully supported by the specification, for example the embodiment disclosed at page 7, line 25 to page 8, line 9 (the first conductive film 12a (corresponds to the claimed first conductive layer) and third conductive film 22a (corresponds to the claimed second conductive layer) may be made of ITO, tin oxide or antimony-tin-oxide (ATO), and the second conductive film 2a (corresponds to the claimed third conductive layer) can be a metal film, such as a silver film. In fact, such consideration of the claim should not even require the present amendment, but as noted earlier, Applicant presents the present amendment as an accommodation to reduce issues to further prosecution. Even without the present amendments to the limitations in claim 24, one reasonably reading previously presented claim 24 would have concluded that the third conductive layer is different in material in reference to that of the first and second conductive layers.

Accordingly, the present amendments to previously presented claim 24 (now claim 1) to address the Examiner's 112 issues should not be deemed to raise new issues requiring further considerations after final action. Any further consideration necessitated would be the direct

result of the Examiner's failure to provide a thorough examination based on a reasonable consideration of the previously present claims.

For at least the same reasons above, similar amendments to previously presented claims 25 and 29 would not raise new issues necessitating further considerations. Similarly amended limitations of previously presented claim 25 have been incorporated in claim 20, and previously independent claim 29 has been similarly amended to address the Examiner's 112 issues.

Concerning the present amendments to previously presented dependent claim 28, they are clearly of a non-substantive, clarifying nature, as the Examiner already noted the supporting specification for the present amendments. The Examiner did not point to a different interpretation that is supported by the specification.

Further, given that the Examiner pointed to the closest interpretation of claim 28, the Examiner should have considered claim 28 in the manner currently amended. Applicant respectfully notes that the Examiner has not applied any substantive prior art rejection of claim 28. Accordingly, claim 28 as currently amended should be deemed to be patentable over the prior art of record. Any further consideration of claim 28 would not have been necessitated by the present amendments. Even if the Examiner maintains the rejection of the other claims, the Examiner should indicate patentability of at least claim 28 in an Advisory Action.

#### Delayed Prosecution

Further to the reasons present above, Applicant respectfully submits that the present amendments after final should be entered and considered, further given consideration of the prolonged prosecution in this case, as a result of a change in Examiner, and the unreasonable delay on the part of the previous Examiner, leading to close to 5 years of pendency of the case

currently. Balancing the fairness to the Applicant, it would be within the Examiner's discretion to enter and consider the present amendments, especially given the non-substantive nature of the present amendments.

#### Claim Rejections Under 35 USC 102

Claims 1, 9-13, 16-20, 22-27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Okahashi (US 6,473,074). This rejection is respectfully traversed.

Given the correct consideration of the limitations recited in previously presented dependent claims 24 and 25, and the incorporation of such limitations in the independent claims 1 and 20 (and claim 29), the independent claims 1, 20 and 29, and all claims dependent therefrom, are not anticipated by Okahashi. Okahashi does not teach the recited: wherein the first conductive layer is formed on the first substrate at the same time with and with the same material as the first conductive surface on the first substrate, and the second conductive layer is formed on the second substrate at the same time with and with the same material as the second conductive surface on the second substrate.

#### CONCLUSION

In view of all the foregoing, Applicant submits that the claims pending in this application are patentable over the references of record and are in condition for allowance. Such action at an early date is earnestly solicited. **The Examiner is invited to call the undersigned representative to discuss any outstanding issues that may not have been adequately addressed in this response.**

The Assistant Commissioner is hereby authorized to charge any additional fees under 37 C.F.R. §§ 1.16 and 1.17 that may be required by this transmittal and associated documents, or to credit any overpayment to **Deposit Account No. 501288** referencing the attorney docket number of this application.

Respectfully submitted,

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